

REMARKS

This application has been carefully reviewed in light of the Office Action of March 13, 2006. Claims 1, 2, 4-12 and 14-39 are presented for examination. Claims 1, 2, 4-6, 8, 10, 12, 14-16, 18-22, 24, 30, 32, 34, 36 and 38 have been amended to define still more clearly what Applicant regards as his invention. Claims 1, 4, 6, 8, 10, 12, 14, 16, 18-21, 34, 36 and 38 are the independent claims. Favorable reconsideration is requested.

Claims 1, 4-12, 14 and 16-39 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent Application Publication 2001/0041056 (Tanaka et al.) in view of Japanese Published patent Application H 06-233044 (Tanaka et al.). In addition, Claims 2, 11 and 15 were rejected under Section 103(a) as being obvious from those documents in view of U.S. Patent 6,313,877 (Anderson et al.).

The general nature of the present invention, and the prior art, have been adequately discussed in previous papers, and it is not believed to be necessary to repeat that discussion in full. Among other important features of the aspects of the present invention set out in independent Claims 1, 4, 10, 12, 14 and 16 are (1) determining whether an image is to be displayed or characters related to the image are to be displayed, and (2) doing this in accordance with the (a) display capability of the image display device and (b) the number of images stored in the image storage device.

To begin with, it is strongly submitted that the rejections based on a proposed combination of *Tanaka '056* and *Tanaka '044* are improper and should be withdrawn, because the proposed combination is one that would not have occurred to one of ordinary skill, for the following reasons.

Tanaka '056 relates to transmission and reception of image information, such as images captured by a digital camera. The *Tanaka '056* system can provide a user remotely with a list of available files (paragraph [0087]), to permit the user to select a file for display. *Tanaka '056* states:

“When the electronic camera **10** receives a command of “Request File List”, processing at **S110** “Produce New Virtual File Structure” is performed. Here, the information processing device **44** newly produces file list information of the virtual directory and virtual image file structure ..., and transmits and presents the file list information classified and produced by category at **S112** “File List Information” to the communication device **80**.” (paragraph [0087])

Tanaka '056 also states:

“Then, the communication device **80** transmits “Request QQVGA Image of Current Frame Number” to the electronic camera **10** at **S118**.... In the electronic camera **10**, processing to read the image file designated by the user from the recording medium **54** is performed at **S120**.... Next, the information processing device **44** of the electronic camera **10** performs processing to read image data from the read image data and produce image data of the QQVGA size at **S122**.... The QQVGA image data of the current frame ... is transmitted to the communication device **80** at **S124**....” (paragraphs [0089] - [0091])

Thus, *Tanaka '056* provides a remote user with a list of file names, with which the user can then access one or more of the corresponding images.

The *Tanaka '044* system prints a received transmission, or outputs a report, based on the number of sheets in the transmission (*Tanaka '044*, paragraphs [0010] and [0027]). The report may include a publication number (for example), if that information is present (paragraph [[0029]).

The motivation stated in the Office Action for the proposed combination of *Tanaka '056* and *Tanaka '044* is:

“Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a determination step as taught by Tanaka (JP) in the image transfer method of Tanaka (US) as

this would allow a user to find a desired picture more quickly if there are a large number of images by searching through only the names of the images which can be loaded much more quickly than thumbnails can be.” Office Action at page 5.

It is respectfully pointed out that in the *Tanaka '056* system, the user is presented with the list of files specifically in order to permit the user to select which images are to be downloaded (Fig. 12; paragraphs [0086] - [0090]). The image is transferred if the user requests that that image be transferred. To add a function like that of *Tanaka '044*, in which a file of over a certain number of sheets is not outputted but is replaced by the outputting of a report, would have no useful effect. The point of the *Tanaka '044* system is to avoid the printing out of transmissions that the user of the system does not want or need, such as ads. In the *Tanaka '056* system, in contrast, when an image is transferred it is precisely because the user has already decided that he or she wants that image. Adding a function like that of *Tanaka '044* would not only not provide a useful function, and would not promote the advantage provided by either disclosure, but would seem actually to impede the desired operation of the *Tanaka '056* system, in that the user who has input an instruction for the downloading of a particular image, would receive a report instead of the image if the image is over a set number of sheets in size. If this happens, of course, the user's intention is frustrated. (And if on the other hand all the images are only a single sheet, then the *Tanaka '044* feature would never come into operation.)

Moreover, the reason suggested in the Office Action for making the proposed combination appears to be, in essence, that presenting the user with a list instead of the images, enables the user to select from among the images more quickly than would be possible if the user had to wait for and then go through the displayed images themselves.

It appears to be the case, on the contrary, that according to *Tanaka '056* the user is *always* presented with the list; it does not appear to be contemplated at all in *Tanaka '056* that the user would ever make a selection otherwise than using the list. Somehow adding the features of *Tanaka '044* would not appear to improve the operation of the *Tanaka '056* system at all.

Accordingly, it is submitted that one of ordinary skill would not have any reason at all to try combining the teachings of *Tanaka '056* and *Tanaka '044*, and that moreover any attempt at such a combination would at best produce a device that would operate less well, not better, than the unmodified *Tanaka '056* device. It is submitted that Claims 1, 4, 10, 12, 14 and 16 are therefore clearly allowable over these two documents.

Nonetheless, to eliminate this as an issue, Applicant has amended these claims to recite that the determination in the display determination step is made based on the display capacity of the device, as well as on the number of images. Even assuming that the proposed combination of *Tanaka '056* and *Tanaka '044* were a proper one, the result of such combination would not meet this recitation, since nothing in either document appears even to hint at determining the display capacity of a device, much less basing any kind of determination on such information. For this reason, it is believed clear that Claims 1, 4, 10, 12, 14 and 16 are allowable over *Tanaka '056* and *Tanaka '044*.

Similarly, among other important features of the aspects of the present invention set out in independent Claims 6, 8, 18, 19, 20 and 21 are (1) determining whether image data is to be transmitted or identification of the image data is to be transmitted by the image storage device to the image display device, and (2) doing so in

accordance with (a) the display capability of the image display device and (b) the number of images stored in the image storage device.

These claims also are believed to be clearly allowable over *Tanaka '056* and *Tanaka '044*, even assuming for argument's sake that the proposed combination thereof would be a proper one.

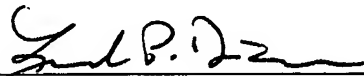
Among other important features of the aspects of the present invention set out in independent Claims 34, 36, and 38 is transmitting data of a kind corresponding to the display capability of the image reception device and the number of images, to the image reception device.

These claims also are believed to be clearly allowable over *Tanaka '056* and *Tanaka '044*, even assuming for argument's sake that the proposed combination thereof would be a proper one.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Leonard P. Diana", written over a horizontal line.

Leonard P. Diana
Attorney for Applicant
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 574564v1